

Appl. No. 09/322,708
Amdt. dated September 11, 2003
Reply to Office Action of June 13, 2003

REMARKS

This Amendment is in response to the Office Action mailed June 13, 2003. In the Office Action, the Examiner rejected claims 1-5 and 10-29 under 35 U.S.C. § 103, and allowed claims 6-9 and 30-37. Applicant has amended claims 1, 10, 16, and 25. Claims 1-37 remain pending in the application. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

Allowable Subject Matter

1. Applicant notes the Examiner's withdrawal of the indicated allowability of claims 10-15.

Rejection Under 35 U.S.C. § 103

4. The Examiner rejects claims 1-4, 10-13, 16-19, 21-23, and 25-28 under 35 U.S.C. § 103(a) as being unpatentable over Yamashita (US 5,351,232), in view of the admitted prior art of Figure 3.

Figure 3 of the instant application is not prior art. Applicant understands the Examiner to have intended Figure 1 which is admitted prior art.

Regarding claims 1, 10, 16, and 25, applicant has amended these claims to add limitations that make clear that the invention as claimed requires that the test data be inserted into the unused fields of the TDM stream by a logic circuit and that the TDM stream be transferred through the components of the transmission system and back to the logic circuit. Yamashita teaches a distinctly different system that inserts test data into a TDM stream using insertion circuits 30₁-30_N, routing the TDM through the system, and checking the test data with a check circuit 32₁-32_N that is in the output path. Yamashita, alone or in combination with the admitted prior art, does not teach or suggest the claimed invention as amended.

Regarding claim 21, the Examiner rejects this claim as having similar limitations to claim 16. Applicant submits that claim 21 is more similar to claim 34, which the Examiner has allowed. Applicant respectfully requests that the Examiner reconsider the rejection of claim 21.

Regarding claims 2-4, 11-13, 17-19, 22-23, and 26-28, applicant relies on the patentability of the claims from which these claims depends to traverse the rejection without prejudice to any further basis for patentability of these claims based on the additional limitations recited.

Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-4, 10-13, 16-19, 21-23, and 25-28 under 35 U.S.C. § 103(a) as being unpatentable over Yamashita, in view of the admitted prior art.

5. The Examiner rejects claims 5, 14, 20, 24, and 29 under 35 U.S.C. § 103(a) as being unpatentable over Yamashita, in view of the admitted prior art of Figure 1 of the instant application, and further in view of Bull et al. (US 4,523,308).

Appl. No. 09/322,708
Amdt. dated September 11, 2003
Reply to Office Action of June 13, 2003

Applicant relies on the patentability of the claims from which these claims depends to traverse the rejection without prejudice to any further basis for patentability of these claims based on the additional limitations recited.

6. The Examiner rejects claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Yamashita (US 5,351,232) in view of the admitted prior art of Figure 3 of the instant application, and further in view of Koenig et al. (US 6,351,452).

Applicant relies on the patentability of the claims from which these claims depends to traverse the rejection without prejudice to any further basis for patentability of these claims based on the additional limitations recited.

Allowable Subject Matter

7. Applicant notes with appreciation the Examiner's allowance of claims 6-9 and 30-37.

Conclusion

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: September 11, 2003

By

James Henry
Reg. No. 41,064
Tel.: (714) 557-3800 (Pacific Coast)

RECEIVED
CENTRAL FAX CENTER
SEP 12 2003

Attachments

OFFICIAL